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FEB 17 2006

OFFICE OF PETITIONS

In re Application of
Bill Tobler et al.
Application No. 10/780,301
Filed: February 17, 2004
Attorney Docket No.: 81091394

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: **DECISION ON PETITION**
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This is a decision on the renewed petition under 37 CFR 1.137(a)¹, filed December 27, 2005 (certificate of mail date December 21, 2005).

The petition under 37 CFR 1.137(a) is **GRANTED**.

This application became abandoned on June 19, 2005, for failure to file a timely response to the non-Final Office Action mailed March 18, 2005, which set a three (3) month period for reply. A petition filed under 37 CFR 1.137(a) and under 37 CFR 1.137(b), filed September 14, 2005 prior to the mailing of the Notice of Abandonment, was dismissed in a decision mailed October 21, 2005 because while petitioner asserted that the non-Final Office Action was never received, petitioner did not present a showing that the Office action was not in fact received and thus that the failure to file a timely response was unavoidable.

An application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure or mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.²

¹ A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee as set forth in § 1.17(l);(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

² Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

The showing required to establish the failure to receive an Office action must include a statement from the inventor that the Office communication was not received and attesting to the fact that a search of the docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in petitioner's statement.⁴

As petitioner has submitted a copy of records used for docketing and asserts that the office action was not received, under the unavoidable the standard the petition is grantable.

On renewed petition, petitioner argues that having claimed the delay was also unintentional in the September 14, 2005 was inadvertent and that they only meant to argue under the unavoidable standard. Unfortunately, both the petition transmittal cover sheet and the petition itself noted 37 CFR 1.137(a) and 37 CFR 1.137(b) and also authorized the charging of the deposit account for any additional required fees.

In that case, there was no way for the USPTO to know petitioner's intent with respect to

³In *re Mattullath*, 38 App. D.C. 497, 514-15 (1912)(quoting *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), *aff'd*, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁴M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

how the petition should be treated was other than how it was captioned.

In view thereof, the charge for treating the petition under the unintentional standard was justified and cannot be reversed and refunded.

This matter is being referred to Technology Center 3683 for appropriate action on the amendment filed December 27, 2005.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in black ink, reading "Patricia Faison-Ball". The signature is written in a cursive, flowing style.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions